

## REMARKS

### Status of the claims

Claims 1-77 are pending. Claims 1, 35-36, 39-40, 43-45 and 49-50 are rejected. Claims 2-10, 14-15, 19-22, 25-26, 30-31, 37-38, 54-57, 60-61, and 65-66 were objected to by the Examiner. Claims 2-3, 31, 36, 38, 43 and 54 are amended. New claims 78-82 are added. Non-elected claims 11-13, 16-18, 23-24, 32-34, 27-29, 32-34, 46-48, 51-53, 58-59, 62-64 and 67-77 are canceled. Pending claims 1, 35 and 37 are canceled. No new matter is added.

The Examiner indicated in Item 1 on page 2 of the Detailed Action that claim 14 was a non-elected claim and thus withdrawn from prosecution. Respectfully, Applicants note that the Restriction Requirement included claim 14 with Applicants' elected Group I claims.

### Claim amendments

No new matter is added by any claim amendment. Claims 2 and 3 are amended as independent claims to recite an isolated and purified mouse urocortin III protein derived from a

precursor with SEQ ID NO: 4 or having a sequence of SEQ ID NO: 5, respectively.

Claim 36 is amended to overcome rejections under 35 U.S.C. 102(e) and 103(b) over *Hsu et al.*. Amended claim 36 incorporates claims 1 and 37 and recites an isolated and purified mouse urocortin III protein of SEQ ID No: 3 with the amino acid substitutions recited in claim 37. Claim 38 is amended to depend from amended claim 36. New claim 78 depends from amended claim 36 and corresponds to original claim 35, which is canceled. Claim 78 limits the protein having SEQ ID NO: 3 to being derived from a precursor having SEQ ID NO: 2.

Claim 31 and claim 43 are amended to properly depend from claim 30 and from claim 42, respectively.

Claim 49 is amended to overcome a rejection under 35 U.S.C. 112, second paragraph to insert the word “of” in the phrase “selected from the group consisting of”.

Claim 54 originally depended from claim 36 and is amended as an independent claim to incorporate claims 1 and original claim 36. Amended claim 54 recites an isolated and purified mouse urocortin III protein of SEQ ID No: 3 with the amino acid substitutions recited in original claim 54. New claims 79-82

depend from amended claim 54 and correspond to original claims 40-43 which depend from claim 36.

Claim objections and allowable subject matter

Claim 31 is objected to for improperly depending from claim 29. Claim 31 is amended to properly depend from claim 30.

Claims 2-10, 14-15, 19-22, 25-26, 30, 37-38, 54-57, 60-61, and 65-66 are directed to allowable subject matter, but are objected to for directly or indirectly depending upon rejected claim 1. As discussed *supra*, Applicants have amended claims 2-3, 36 and 54 as independent claims and canceled claim 1. Applicants respectfully submit that claims 2-10, 14-15, 19-22, 25-26, 30-31, 37-38, 54-57, 60-61, and 65-66 are in condition for allowance and request that the objection to these claims be withdrawn.

The 35 U.S.C. §112, second paragraph rejections

Claim 49 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants respectfully traverse this rejection.

Claim 49 is indefinite for not reciting the complete phrase “selected from the group consisting of”. Claim 49 is amended to include the word “of” in the phrase. Accordingly, Applicants respectfully request that the rejection of claim 49 under 35 U.S.C. 112, second paragraph, be withdrawn.

The 35 U.S.C. §102(e)-103(a) rejections

Claims 1, 35-36, 39, 44-45 and 49-50 stands rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Hsu et al.** (U.S. Pub. No. 2002/0082409 A1). Applicants respectfully traverse these rejections.

The Examiner states that **Hsu et al.** teach a stresscopin peptide of SEQ ID NO: 6 that shares 100% identity with Applicants’ protein having SEQ ID NO: 3 except for two additional amino acids at the N-terminus. **Hsu et al.** also teach amino terminus deletions (PP0022) and amino acid substitutions (PP0023) and that groups may be introduced during synthesis of the peptide to allow linking through carboxyl groups, for example, to other molecules and surfaces (PP 0027). The Examiner also states that **Hsu et al.** do not expressly teach the substitutions recited in Applicants’ claims 37-38

and 54. Furthermore, the Examiner states that claims 37-38 would be allowable if not dependent upon rejected claim 1.

Applicants have canceled claim 35 which depended from claim 1 and have amended claim 36, which depended from claim 35, as an independent claim to incorporate the limitations of claim 1 and dependent claim 37. As amended, Applicants' claimed invention is to an isolated and purified human urocortin III protein having the sequence of SEQ ID No: 3 with the amino acid substitutions recited in claim 37.

As claim 36 is amended to incorporate the limitations of an allowable claim, amended claim 36 and claims 39, 44-45, 49-50 which depend from amended claim 36 are thus novel and non-obvious over **Hsu et al.** Accordingly, in view of the claim amendments presented herein, Applicants respectfully request that the rejection of claims 1, 35-36, 39, 44-45 and 49-50 under 35 U.S.C. 102(e) or, in the alternative, under 35 U.S.C. 103(a) be withdrawn.

The 35 U.S.C. §103(a) rejection

Claims 1, 35-36, 39-40, 43-45 and 49-50 are rejected under 35 U.S.C. 103(a) as obvious over **Hsu et al.** Applicants respectfully traverse this rejection.

The Examiner states that **Hsu et al.** teach modifying peptides to include residues other than naturally occurring L-amino acids, such as D-amino acids or non-naturally occurring synthetic amino acids ((PP0025). The Examiner further states that **Hsu et al.** teach that stresscopin peptides may be labeled with radioisotopes (PP0035). Although, **Hsu et al.** do not expressly teach the use of D-iodotyrosine or 125-I, one of ordinary skill in the art would have expected success in using these common agents given the teachings of **Hsu et al.** Thus, the claimed invention was within the ordinary skill in the art to make and use at the time of the instant invention and is, therefore, was as a whole prima facie obvious.

Amended claim 36 and dependent claims 39, 44-45 and 49-50 are both novel and non-obvious over **Hsu et al.** Claims 40 and 43 also depend from amended claim 36 and, as such, also are not obvious in view of **Hsu et al.** Accordingly, in view of the claim amendments presented herein, Applicants respectfully request that

the rejection of claims 1, 35-36, 39-40, 43-45 and 49-50 under 35 U.S.C. 103(a) be withdrawn.

Applicants submit that claims 2-10, 14-15, 19-22, 25-26, 30-31, 36, 38-45, 49-50, 54-57, 60-61, 65-66, and 78-82 are in condition for allowance. Accordingly, Applicants request that these claims be passed to issuance.

This is intended to be a complete response to the Office Action mailed April 8, 2004. If any issues remain, please telephone the undersigned attorney for immediate resolution. Applicant believes no fees are due, however, if this is in error, please debit any fees due from Deposit Account No. 07-1185 on which Applicant's counsel is allowed to draw.

Respectfully submitted,

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Benjamin Aaron Adler, Ph.D., J.D.  
Registration No. 35,423  
Counsel for Applicant

ADLER & ASSOCIATES  
8011 Candle Lane  
Houston, Texas 77071  
(713) 270-5391 (tel.)  
(713) 270-5361 (facs.)  
badler1@houston.rr.com